



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,084	10/04/2006	Anja Eitrich	P30301	5886
7055 7590 10/16/2009 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER				
BROWL, DAVID				
ART UNIT		PAPER NUMBER		
1616				
NOTIFICATION DATE		DELIVERY MODE		
10/16/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary

Application No.

10/589,084

Applicant(s)

EITRICH ET AL.

Examiner

DAVID M. BROWNE

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006 and 30 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-33 is/are pending in the application.
- 4a) Of the above claim(s) 11-31 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 11-33 are pending; claims 1-10 are cancelled.

Foreign Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed for German Patent Application No. 10 2004 006.830.5, filed on February 11, 2004.

Domestic Benefit

Applicant's claim for the benefit of International Patent Application No. PCT/EP05/50134, filed January 13, 2005, under 35 U.S.C. 365(c) is acknowledged.

Election/Restrictions

Applicant's election of Group IV, claim 32, in the reply filed on September 30, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 11-31 and 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 30, 2009.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ziegler *et al.* (U.S. Patent No. 5,232,688), in view of Scott *et al.* (European Patent Application No. 98304273.0).

Applicant Claims

Applicants claim a method of providing skin with a natural tanned color comprising applying to the skin an effective amount of a cosmetic self-tanning

composition containing dihydroxyacetone and glycerin. The glycerin comprises more than 5% by weight of the total weight of the composition.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Ziegler *et al.* disclose a method of providing skin with a natural tanned color comprising applying to the skin an effective amount of a cosmetic self-tanning composition containing dihydroxyacetone and glycerin (Col. 1, Ins. 6-8, 24-26; Col. 2, Ins. 1-4, 30-34, 37-40, 51-52; Col. 6, Ins. 12-13, 15-37). The glycerin comprises more than 5% by weight of the total weight of the composition, and has a color enhancing interaction with dihydroxyacetone (Col. 6, Ins. 12-13, 15-37).

Scott *et al.* disclose a method of providing skin with a natural tanned color comprising applying to the skin an effective amount of a cosmetic self-tanning composition containing dihydroxyacetone and glycerin (Pg. 2, Ins. 7-10; Pg. 5, Ins. 49-56; Pg. 6, Ins. 45-48; Pg. 7, Ins. 54-58; Pg. 8, Ins. 1-3; Pg. 11, Ins. 12-22). The glycerin can comprise more than 5% by weight of the total weight of the composition, and has a stabilizing effect on dihydroxyacetone (Pg. 5, Ins. 49-56; Pg. 11, Ins. 12-22).

Ascertainment of the Difference Between the Scope of the Prior Art and the Claims (MPEP §2141.012)

Ziegler *et al.* and Scott *et al.* disclose that glycols and polyols, respectively, enhance the natural tanning effect and stability of dihydroxyacetone. Ziegler *et al.* disclose that propylene glycol has the most potent color enhancing interaction with dihydroxyacetone among the glycol agents tested, and Scott *et al.* disclose that D-sorbitol is the preferred polyol agent for dihydroxyacetone stabilization. Both Ziegler *et*

al. and Scott *et al.*, however, include glycerin in the generic list of glycol and polyol agents that can have a similar effect. Although the respective generic lists are too extensive in each case to anticipate the specific and exclusive choice of glycerin, the disclosures are sufficient to render the use of glycerin obvious under 35 U.S.C. 103.

Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)

It would have been *prima facie* obvious for one of ordinary skill in the art at the time of the present invention to combine the teachings of Ziegler *et al.* and Scott *et al.* to arrive at a method of providing skin with a natural tanned color comprising applying to the skin an effective amount of a cosmetic self-tanning composition containing dihydroxyacetone and more than 5% glycerin. Dihydroxyacetone is one of the most widely used topically applied self-tanning agents on the market, and is well known in the art to not provide the desired control over color development and suffer from a short shelf life due to chemical instability. Since Ziegler *et al.* and Scott *et al.* disclose that more than 5% w/w glycerin has, respectively, a color enhancing and stabilizing effect with dihydroxyacetone, one of ordinary skill in the art would be motivated to formulate a self-tanning composition containing dihydroxyacetone with more than 5% w/w glycerin with the reasonable expectation that the composition will successfully exhibit improved color development, chemical stability and shelf life. Therefore, the claimed invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID M. BROWE whose telephone number is 571-270-1320. The examiner can normally be reached on Monday-Friday 7:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DAVID M. BROWE
Patent Examiner, Art Unit 1616

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616